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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,438	03/15/2004	J. Gilmore Childers	G08,129/U	3078
54205 7590 06/15/2009 CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
LIE, ANGELA M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,438

Applicant(s)

CHILDERS ET AL.

Examiner

ANGELA M. LIE

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-14 are currently pending in this application.
2. Claim 15 has been canceled.
3. Claims 1-14 are rejected under 35 U.S.C 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farnham et al (US Patent No. 7167910), hereafter referred to as Farnham, in view of Daniell et al (US Publication No. 2004/0158611), hereafter referred to as Daniell.**

As to claims 1, 5, 10, and 13, Farnham teaches a system and a method comprising: receiving, into memory of a computer system, information descriptive of two or more persons (Figure 2, step 202); generating, in the computer system, links associating two or more persons based upon the received information, wherein the links indicate a relationship between the two or more persons (Figure 4, wherein links connect individuals and Figure 2, step 212); receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation (Figure 1, elements 110, 112, 114 and 116, wherein a social map/network

can be created based on adjusted groupings, in particular the lowest degree of separation includes individuals with whom at least a predetermined number of email correspondence was exchanged (column 4, lines 62-67 and column 5, lines 1-4)); generating, in the computer system, a link associating the identified person with one or more other persons with the specified number of degrees of separation (Figure 2, steps 204, 206 and 208 and column 6, lines 46-62, wherein the cluster closest to the user is considered lower degree of separation while cluster having a lengthier distance from the user is considered having greater degree of separation); and outputting for utilization in risk management (this limitation is considered to be associated with intended use rather than actual change of the scope of the method or the system claimed) an indication of the link associating the identified person with the one or more other persons with the predefined specified number of degrees of separation (Figure 2, step 212 and Figure 1, element 100). Farnham, however does not explicitly teach that an indication of one or more disconnects between the identified person and the one or more other persons, wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons. On the other hand, Daniell teaches a system for displaying social network in a form of a Instant Messenger list wherein a main user can easily view which of his/her friends from the social network are online and which one are offline (i.e. indication of disconnect indicating separation in time because those individuals are currently unavailable) (paragraph [0062], and also illustrated in figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Daniell about including an indicator

whether an individual is offline (separated in time since he/she can not be contacted in a real-time) with Farnham's teaching about generating social map, in order to allow viewing which individuals are available online, in case the user desires to contact any of the people in the network. Moreover, the Examiner would also like to note that the above combination would be possible because Franhan embraces utilizing Instant messaging contacts (column 3, line 40).

As to claims 2, 3, 8 and 11, Franham further teaches a system and a method comprising the step of: receiving an indication of a particular type of link to be analyzed (Figure 1, wherein a user sets criteria according to which the type of link is determined, i.e. selecting contacts that are related to the user based on the predetermined criteria); and indicating a degree of separation between the identified person and the linked person (column 6, lines 46-62, wherein each successive cluster positioned further away from the user is considered having greater degree of separation with respect to the clusters that are located closer to the user).

As to claims 4, 9, 12 and 14, Franham also teaches a system and a method wherein the person comprises at least one of: an individual, a group, an organization, a corporation (column 3, lines 10-13).

As to claim 6, Franhan teaches a system wherein the system access device comprises at least one of a computer (column 3, line 37) and a personal digital assistant.

As to claim 7, Franhan teaches a system wherein a communications network conforms to the transmission control protocol/ internet protocol (column 4, lines 7,

wherein internet protocol has to be utilized in order to access at least one of the applications such as Exchange, Instant Messenger etc).

Response to Arguments

6. Applicant's arguments filed March 2, 2009 have been fully considered but they are not persuasive.

7. *With respect to the Applicant's first argument on page 7 last paragraph bridging to page 8, alleging that "Office Action mischaracterizes claim components and/or aspects of Farnham ... Moreover, there is no discussion in the rejection as to how " the number of times [a] person appears as a recipient or sender of email" is allegedly equivalent to the "predefined specified number of degree of separation".*

8. The Examiner disagrees with the above argument. It appears that the Applicant is not clear on how the number of emails (i.e. number of occurrences) exchanged between users relates to degrees of separation. Therefore, the Examiner would like to take a moment to explain it in more detail. In particular, the number of email sent and received indicates how much correspondence individuals exchange. Thus, more frequent correspondence would translate to lower degree of separation, since two individuals are in constant contact. Similarly, if two individuals barely exchange emails, they are most likely not very close too each other, hence the degree of separation would be higher. Moreover Farnham teaches that the social network can be limited by number of occurrences (i.e. number of correspondence exchanged), and this in fact is interpreted as a specifying degree of separation.

9. Additionally, the Examiner would also like to point out that the original specification does not define the meaning of "degree of separation". There are few examples, however none of them could be considered, deliberate definition. Furthermore, current claim language does not invalidate the interpretation of "degree of separation" that had been allotted by the Examiner.
10. Accordingly, the Examiner maintains that Farnham indeed discloses "predefined specified number of degree of separation".
11. Furthermore, also on page 8, the Applicant contends that "the cited portion of Daniell in no way addresses "disconnects ... wherein in disconnect indicates a separation in time regarding the link associating the identified person with one or more other persons".
12. The Examiner again disagrees with the Applicant's assertion. In particular a colorful indicator signifying whether another person is or is not available to being contacted, certainly can be considered a type of disconnect indicating a separation in time regarding link associating two people (i.e. a user and another person on a list of contacts). In particular, disconnect is interpreted as unavailability of another person at a particular point in time. Similarly to degree of separation discussed in the previous argument, claim language does not include any language which would invalidate such an interpretation. It also appears that the original disclosure lacks further clarification/definition on how the disconnect should be interpreted. Consequently, the Examiner maintains that Daniell indeed teaches "disconnects ... wherein in disconnect

indicates a separation in time regarding the link associating the identified person with one or more other persons".

13. *Then on the following page, the Applicant argues that "the pending rejection has provided no indication of the level or ordinary skill in the art". The Applicant also submits that the impermissible hindsight has been applied in asserting obviousness".*

14. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

15. In addition, the Examiner would also like to note that the Applicant simply speculates whether one of ordinary skill in the art could or could not determine if it is obvious to modify Farnham's teaching based on Daniell's disclosure. On contrary to the Applicant's allegation, the Examiner maintains that indeed one of ordinary skill in the art would consider it obvious to modify Farnham's teaching with Daniell's. In particular Farnham teaches that the social network can be used along with Instant Messenger (column 3, line 40), Hence utilizing indicators of disconnect such as offline, taught by Daniell's, would be more than obvious to find a use in Farnham's social network.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiry

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA M. LIE whose telephone number is (571)272-8445. The examiner can normally be reached on M-F.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung T Vy/
Primary Examiner, Art Unit 2163

/Angela M Lie/
Examiner, Art Unit 2163